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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
077330,446	03/30/89	YOSHIMURA	1173145P

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EXAMINER
CARLSON, K

ART UNIT	PAPER NUMBER
1653	34

DATE MAILED: 02/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
07/330,446

Applicant(s)
Yoshimura, et al.

Examiner
Kar n Cochran Carls n

Group Art Unit
1653



☒ Responsive to communication(s) filed on Oct 25, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4, 6, 7, and 20-25 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6, 7, and 20-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This Office Action is in response to Paper #33, filed October 25, 1999. Claims 5 and 8-19 have been canceled. Claims 1-4, 6, 7, and 20-25 are currently under examination.

5 Maintenance of Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

10 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15 Claims 21-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

20 Claims 21-25 are directed to monocyte chemotactic protein isolated from primate, murine, porcine, equine, and bovine sources. The specification describes isolation of the protein from human cells. It does not describe isolation of the protein from other sources. It is unknown if applicants were in possession of the protein from the sources other than human cells at the time the application was filed. The specification does not provide sufficient information regarding the protein isolated from other cells so that one
25 skilled in the art would understand what their structures are. Therefore, monocyte chemotactic proteins isolated from sources other than human cells are not adequately described in the specification.

30 Applicants argue that because the specification discusses multiple sources for the present claimed peptide, and the isolation and purification of the peptide is well within the skill of the ordinary artisan, then the

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specification meets the written description requirement. This argument is not persuasive because one skilled in the art does not know what the claimed peptide from primate, murine, porcine, equine, and bovine looks like. Therefore, the specification fails to provide a written description of these peptides and the claims are rejected under 35 USC 112, first paragraph, accordingly. Applicants are referred to *University of California v. Eli Lilly* 119F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997), wherein the cDNA sequence describing a single species did not provide basis for claiming any other specific species or genus of cDNA.

New Rejections:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 7, and 20-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-29 of copending Application No. 07/686264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to peptides with overlapping sequences, sources, and/or activities.

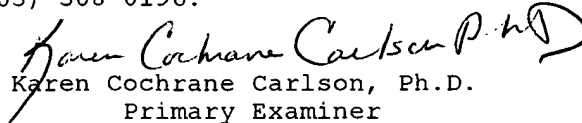
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is (703) 308-0034. The Examiner can normally be reached daily except alternate Fridays from 7:30 A.M. to 5:00 P.M.

5 If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Christopher Low, can be reached at (703) 308-2923. The OFFICIAL fax phone number for Technology Center 1600 is (703) 308-4242.

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.


Karen Cochrane Carlson, Ph.D.
Primary Examiner